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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: E. Hebert *et al.*

Attorney Docket No: 20002.0067

Application No.: 09/625,544

Group Art Unit: 1732

Filed: July 25, 2000

Examiner: Edmund Lee

For: METHOD OF FORMING A MULTILAYER
GOLF BALL WITH A THIN THERMOSET
OUTER LAYER

DECLARATION OF JOHN P. MULGREW UNDER 37 CFR § 1.132

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Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

I, John P. Mulgrew, hereby declare the following:

1. I am a citizen of the United States, and reside at 11012 Langton Arms Court, Oakton, Virginia 22124.
2. I am an attorney representing the assignee in this application by virtue of a Power of Attorney by Assignee, ACUSHNET COMPANY (formerly doing business as Titleist and Foot-joy Worldwide), 333 Bridge Street, Fairhaven, MA 02719, the Assignee of record of the entire, right, title and interest in the invention, to prosecute the above-referenced patent application.
3. I have worked on patent prosecution matters for Assignee for at least 5 years and can attest to procedures used by the current firm and the prior firm in preparing and filing patent applications for Assignee. I can also attest to internal procedures used by Assignee in reviewing and selecting inventions for preparing patent applications.
4. Since 2001, I have been employed by Swidler Berlin Shereff Friedman, LLP. I presently hold the position of Of Counsel.

5. This declaration and the concurrently submitted Declaration of William E. Morgan under 37 CFR §1.131 (the Morgan Declaration) are filed to provide evidence to traverse the rejections made in the July 16, 2003 final Office Action. Attached hereto as Exhibit 1 is a copy of U.S. Patent No. 5,733,428 to Calabria (the '428 patent). The '428 patent demonstrate that we conceived and reduced to practice the claimed invention prior to December 23, 1996.

6. With regard to the claimed invention, the only independent claim currently pending is claim 26. That claim recites the following features:

A method of forming a golf ball comprising the steps of

- (a) forming a golf ball core;
- (b) forming an inner cover layer around said golf ball core with a material having a first shore D hardness, wherein forming the inner cover layer comprises compression molding the inner cover material; and
- (c) casting an outer cover layer around said inner cover layer and golf ball core with a thermoset material having a second shore D hardness less than the first, wherein casting the outer cover layer comprises:
 - (i) placing the golf ball core in core holder;
 - (ii) gelling the thermoset material in the first mold half;
 - (iii) placing the golf ball core in to the gelling thermoset material in the first mold half,
 - (iv) disengaging the golf ball core from the core holder after a selected period of time
 - (v) placing the golf ball core, while still in said first mold half with the thermoset material against a second mold half having additional thermoset material and mating the two mold halves together; and
 - (vi) curing the thermoset material in the mated mold halves.

7. Elements (a) and (b) are supported by the Morgan Declaration. In particular, element (a) is described in, for example, the Invention Record (Exhibit A of the Morgan Declaration) at page 3, line 11, and in the inventor notes at page 1 (Exhibit B of the

Morgan Declaration). Element (b) is described in, for example, the Invention Record at page 3, line 12, the inventor notes at page 3 and 4, and the product information sheets for SURLYN® 7930 and SURLYN® 8140 (Exhibit C of the Morgan Declaration). The Morgan Declaration will further discuss and highlight support for these elements. Accordingly, the Morgan Declaration and attached Exhibits show that Applicants conceived and reduced to practice these elements of the claimed invention.

8. The first portion of element (c) is directed to casting a thermoset outer cover layer over the inner cover layer where the outer cover layer has a Shore D hardness less than the inner cover layer and is supported by, for example, the Invention Record at page 2, lines 15-16, page 3, lines 13-17 and the specification at page 6, lines 21-26. The Morgan Declaration will further discuss and highlight support for these elements. Accordingly, the Morgan Declaration, attached Exhibits and specification show that Applicants conceived and reduced to practice this element of the claimed invention.
9. The remainder of elements (c) recites steps for carrying out the casting process as elements (i)-(vi) and is supported by the '428. The '428 patent indicates that Dean Snell's development of the casting process predates December 23, 1996. Dean Snell is a co-inventor of this application who also helped develop the casting that ultimately resulted in the '428 patent. Dean Snell's development of the casting process as claimed in the present invention predates December 23, 1996. Because the present application is filed after November 29, 1999, the provisions of 35 U.S.C. §103(c) apply. The current application has a priority claim to a parent application filed May 27, 1997. The '428 patent did not issue until 1998. Thus, the '428 patent is only available as prior art under 35 U.S.C. §102(e). Further, the '428 patent and the presently claimed invention were commonly owned or subject to an obligation of assignment to the same entity at the time the invention was made. Because of its limited availability as prior art, 35 U.S.C. §103(c) provides that the '428 patent may not be relied upon to reject the claims. Therefore, while the reference demonstrates conception and reduction of practice of some elements of the presently claimed invention, it is not prior art.

10. Element (i) of claim 26 concerns placing the golf ball core in a core holder. One example for support for this element is found in the '428 patent at column 3, lines 53-54, describing a ball cup (core holder) that holds a ball core. Another example of support for this element is found in Figures 3 and 3a, which illustrates the ball cup (core holder). Accordingly, the '428 patent shows that Applicants conceived and reduced to practice this element of the claimed invention.
11. Element (ii) of claim 26 concerns gelling the thermoset material in a first mold half. One example for support of this element is found in the '428 patent at column 5, lines 38-52, which describes mixing of a prepolymer of a thermoset material (polyurethane) and a curative that is fed into a top mold half (first mold half) and allowed to react for a period of time before a core is placed into the mold half. Accordingly, the '428 patent shows that Applicants conceived and reduced to practice this element of the claimed invention.
12. Element (iii) of claim 26 concerns placing the golf ball core into the gelling thermoset material in the first mold half. One example for support of this element is found in the '428 patent at column 5, lines 52-56, describing the core being placed into the gelling thermoset material. Accordingly, the '428 patent shows that Applicants conceived and reduced to practice this element of the claimed invention.
13. Element (iv) of claim 26 concerns disengaging the golf ball core from the core holder after a period of time. Support for this element may be found, for example, in the '428 patent at column 5, line 66 to column 6, line 7, describing the release of the core after the thermoset material is allowed to gel for a period of time. Accordingly, the '428 patent shows that Applicants conceived and reduced to practice this element of the claimed invention.
14. Element (v) of claim 26 concerns placing the golf ball core, while still in the first mold half, against a second mold half having additional thermoset material and mating the two mold halves. Support for this element may be found, for example, in the '428 patent at column 6, lines 1-7, describing that the first mold half having a core and solidified cover half is mated with a second mold half having additional

thermoset material. Another example of support for this element is found in Figure 6 of the '428 patent illustrates a mold half having golf ball core and a solidified cover half that is inverted and ready to be placed into a second mold half that is being filled with a pre-gelled thermoset material. Accordingly, the '428 patent shows that Applicants conceived and reduced to practice this element of the claimed invention.

15. Element (vi) of claim 26 concerns curing the thermoset material in the mated mold halves. One example of support for this element is found in the '428 patent at column 6, lines 38-45, describing the curing process of clamping the mold halves under a given pressure and temperature for a period of time. Accordingly, the '428 patent shows that Applicants conceived and reduced to practice this element of the claimed invention.

REASONABLE DILIGENCE

16. This Declaration is also filed to show reasonable diligence during the critical period. According to MPEP §2138.06, “the critical period for diligence for a first conceiver but second reducer begins not at the time of conception of the first conceiver, but just prior to the entry in the field of the party who was first to reduce to practice and continues until the first conceiver reduces to practice.” Accordingly, the critical period covers a five month period between December 26, 1996 to May 27, 1997.
17. According to MPEP §2138.06, diligence may include either “attorney-diligence”, “engineering-diligence”, or both. In the present application, the attorney diligence alone predates December 26, 1996.
18. The process for internal review of inventions by the Assignee involve an inventor preparing and submitting an invention record to a patent committee. The patent committee meets frequently, usually once each month, to review and discuss invention records that have been submitted since the previous committee meeting was held. The internal review of invention records is thus conducted in the order in which the invention records are submitted.

19. If the committee approves of preparing a patent application for an invention, the invention record is then provided to Applicants' representatives. Applicants representatives then assign an attorney or patent agent to prepare the application. The attorney or agent will then meet with the inventor or inventors to discuss and further understand every aspect of the invention. Meetings of this kind are usually conducted on a monthly basis.
20. After reviewing and discussing the invention record with the inventors, the attorney or agent will then prepare a draft of the application for review by the inventor or inventors. The attorney or agent will address any comments or changes that an inventor may have, and then prepare a second draft of the application. Second drafts of applications are then reviewed by one or more members of the patent committee who may be selected to review the application based on their technical expertise or experience.
21. Any comments to the second draft of the application from the patent committee are then discussed with the inventor and a final draft is prepared. After reviewing and approving the final draft, the inventors and company representatives sign the necessary forms for filing the application and return them to the attorney or agent for filing.
22. At each step of the process described above, preparation and filing of patent applications are handled in chronological order. In general, the time period between when an inventor submits an invention record and the actual filing of a patent application is longer than the 5-month period needed here in order to swear behind the Sullivan '356 patent. Thus, it is reasonable to take from 6-12 months to prepare and file a patent application after the invention record is written and signed by the inventor(s).
23. Here, the drafting process for this application in particular began prior to the critical date of the Sullivan patent.

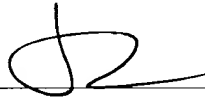
24. Based on my personal knowledge of the attorneys handling the preparation and filing of this application, I believe the attorneys handling preparation and filing of the present application worked diligently by expeditiously handling their case load in chronological order during the 5-month critical period between the filing of the present application and the critical date of Sullivan '356.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: _____

12/16/03

Respectfully Submitted,



John P. MULGREW